

**REMARKS**

An excess claim fee payment letter is submitted herewith for four (4) additional claims.

Claims 1-24 are all the claims presently pending in the application. The Title and claims 1-3, 7-8, 11, and 13-20 are amended to more clearly define the invention and claims 21-24 are added. Claims 1, 8, 11, and 18-20 are independent.

Applicant appreciates the courtesies extended to Applicant's representative during a personal interview on November 18, 2003. During the personal interview, the Examiner's discussed the meaning of "time data" and the features of the claimed invention in comparison with the Shaffer et al. reference with the Applicant's representative.

These amendments are made only to more particularly point out the invention for the Examiner and not for narrowing the scope of the claims or for any reason related to a statutory requirement for patentability.

Applicant also notes that, notwithstanding any claim amendments herein or later during prosecution, Applicant's intent is to encompass equivalents of all claim elements.

Claims 1, 6, and 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the Shaffer et al. reference (U.S. Patent No. 6,477,374). Claims 2, 7, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Shaffer et al. reference and further in view of the Villa-Real reference (U.S. Patent No. 4,481,382). Claims 3-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Shaffer et al. reference and further in view of the Villa-Real reference. Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Shaffer et al. reference and further in view of the Smith reference (U.S. Patent No. 5,822,400). Claims 9, 10, and 16 stand rejected under 35 U.S.C. § 103(a) as being

unpatentable over the Shaffer et al. reference and the Smith reference and further in view of the Villa-Real reference. Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over reference Shaffer et al. reference and further in view of the Groff reference (U.S. Patent No. 4,405,839). Claims 12-14 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Shaffer et al. reference and the Groff reference and further in view of the Villa-Real reference. Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Shaffer et al. reference and further in view of the Smith reference. Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Shaffer et al. reference and further in view of the Groff reference.

These rejections are respectfully traversed in the following discussion.

## **I. THE CLAIMED INVENTION**

A first exemplary embodiment of the claimed invention, as defined by independent claim 1, is directed to an alert control method in telephone equipment having an alert function. The method includes a) storing time data related to a name of a person to communicate with in a phonebook database, b) determining based on the time data whether a predetermined time interval has elapsed without communicating with the person, and c) alerting when it is determined that the predetermined time interval has elapsed without communicating with the person.

A second exemplary embodiment of the claimed invention, as defined by independent claim 8, is directed to an alert control method in telephone equipment having an alert function. The method includes a) storing a last-communication time of day related to a name of each of a plurality of persons to communicate with in a phonebook database b)

dividing the plurality of persons into a plurality of groups, c) determining a before-alert time interval for each of the groups, d) determining whether the before-alert time interval has elapsed after the last-communication time of day, and e) alerting when it is determined that the before-alert time interval has elapsed after the last-communication time of day. The before-alert time interval is a time interval during which communication with the person is not made before alerting.

A third exemplary embodiment of the claimed invention, as defined by independent claim 11, is directed to an alert control method in telephone equipment having an alert function. The method includes a) a storing time data related to a name of a person to communicate with in a phonebook database, b) storing an alert-inhibition time period during which alert is inhibited, c) determining based on the time data whether a predetermined time interval has elapsed without communicating with the person, d) alerting when a current time of day falls out of the alert-inhibition time period and it is determined that the predetermined time interval has elapsed without communicating with the person, and e) inhibiting alert when the current time of day falls into the alert-inhibition time period even if it is determined that the predetermined time interval has elapsed without communicating with the person.

A fourth exemplary embodiment of the claimed invention, as defined by independent claim 18, is directed to a telephone apparatus having an alert function. The apparatus includes a phonebook database for storing time data related to a name of a person to communicate with, and a controller for determining based on the time data whether a predetermined time interval has elapsed without communicating with the person and starting the alert function when it is determined that the predetermined time interval has elapsed without communicating with the person.

A fifth exemplary embodiment of the claimed invention, as defined by independent claim 19, is directed to a telephone apparatus having an alert function. The apparatus includes a phonebook database for storing a last-communication time of day related to a name of each of a plurality of persons to communicate with, and a controller for determining a before-alert time interval for each of the groups, determining whether the before-alert time interval has elapsed after the last-communication time of day, and starting the alert function when it is determined that the before-alert time interval has elapsed after the last-communication time of day. The before-alert time interval is a time interval during which communication with the person is not made before alerting and the plurality of persons is divided into a plurality of groups.

A sixth exemplary embodiment of the claimed invention, as defined by independent claim 20, is directed to a telephone apparatus having an alert function. The apparatus includes a phonebook database for storing time data related to a name of a person to communicate with, an alert-inhibition timetable storing an alert-inhibition time period during which alert is inhibited, and a controller for determining based on the time data whether a predetermined time interval has elapsed without communicating with the person, starting the alert function when a current time of day falls out of the alert-inhibition time period and it is determined that the predetermined time interval has elapsed without communicating with the person, and inhibiting alert when the current time of day falls into the alert-inhibition time period even if it is determined that the predetermined time interval has elapsed without communicating with the person.

While some conventional telephones store a communication history of calls that are received from and placed to a particular person, if a user forgets to check the communication

history then a person who has called the user might not receive a reply from the user.

Another conventional telephone system includes a voice mail system that records the time that a person left a voice mail and the system determines whether a predetermined period of time has elapsed since the voice mail was received and provides an alert if communication with the person that left the voice mail has not been established within the predetermined period of time. However, using this conventional telephone system, a user can only be alerted about an incoming call.

The feature of claims 1 and 18 is to make an alert when a predetermined time interval has elapsed without communicating with a person based on time data stored in phone book database, in which the time data is associated with the name of the person. Since the alert is made when the predetermined time interval has elapsed without communicating with the person, the communication can be ensured without checking the calling or called history.

The feature of claims 8 and 19 is that a plurality of persons are divided into a plurality of groups in the phone book database and a before-alert time period is determined for each group. Accordingly, a before-alert time period can be automatically determined for all persons belonging in the same group, resulting in enhanced operability.

The feature of claims 11 and 20 is that an alert-inhibition time period during which alert is inhibited is stored and, when a current time of day falls into the alert-inhibition time period, alert is inhibited. Accordingly, a beeper sound or vibration is prevented from annoying people around the telephone in conference or in sleep.

Further regarding claims 2 and 12, in stark contrast with the conventional telephones, the present invention stores data regarding when communication was actually established with a person and then determines whether a predetermined time has elapsed since

communication was last established. This feature is important for determining whether a predetermined time interval has passed since that last communication and providing an alert when that predetermined time interval has been exceeded. In this manner, the present invention ensures that a user is able to maintain periodic communications with a person.

Additionally, regarding new claims 21-24, these claims recite storing the time data in response to termination of a call to the person, this feature allows for a telephone equipment in accordance with the invention to automatically store the time data in the phonebook so that an alert may automatically be set to occur a predetermined interval after the stored time data without requiring the user to initiate such a process.

## **II. THE PRIOR ART REJECTIONS**

### **A. The 102(b) Shaffer et al. reference rejection**

Regarding the rejection of claims 1, 6, and 18, Applicant notes that the Office Action applies the Shaffer et al. reference against the present application under 35 U.S.C. § 102(b). However, the patenting date of the Shaffer et al. reference is November 5, 2002 which is after the filing date of September 7, 2000 of the present application. Therefore, the Shaffer et al. reference is not available as a reference against the present application under 35 U.S.C. § 102(b).

Therefore, Applicant respectfully requests withdrawal of this rejection.

The following remarks are provided for the Examiner, only for the possibility that the Examiner considers applying the Shaffer et al. reference under 35 U.S.C. § 102(e) in another Office Action. If the Examiner decides to apply the Shaffer et al. reference under 35 U.S.C. § 102(3), the Applicant respectfully submits that any such office action cannot be made a Final

rejection.

The Examiner alleges that the Shaffer et al. reference teaches the claimed invention. Applicant submits, however, that there are elements of the claimed invention which are neither taught nor suggested by the Shaffer et al. reference.

The Examiner alleges that “time data” is a time at which the wireless communication device enters into a cell of a private network (col. 8, lines 24-35), or the time and date of an incoming call detected by the TOL server 804 (col. 12, lines 43-49).

Rather, the Shaffer et al. reference is directed to determining based on the detected time whether the wireless communication device 202 stays in the cell, or routing the call to an appropriate destination based on the incoming call time. Accordingly, such time information is completely different from the time information that is recited in claim 1. It is the same with respect to the other independent claims 8, 11, and 18-20.

The Shaffer et al. reference discloses a telecommunication system in which if a caller does not receive a response from the user, the caller selects the call back information, and a predetermined time period after the caller set up, a reminder window (1270) appear on the caller’s screen.

Further, regarding new claims 21-24, the Shaffer et al. reference does not teach or suggest that an alert is made when a predetermined time interval has elapsed without communicating with a person based on time data stored in a phone book database in response to termination of a call to the person.

The Shaffer et al. reference appears to disclose an enhanced call back feature at col. 16, line 15 - col. 17, line 10. This enhanced call back feature appear to disclose allowing a user to select a call back information window where the caller may enter data so that the

caller may be prompted to call again after a predetermined period has elapsed.

The Shaffer et al. reference does not teach or suggest telephone equipment that stores time data related to a name of a person in a phonebook database in response to termination of a call to the person. Rather, in stark contrast, the Shaffer et al. appears to require that the caller initiate a process of setting a predetermined time after which a reminder window appears to prompt the caller to place another call.

Therefore, the Shaffer et al. reference does not teach or suggest each and every element of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection of claims 1, 6, and 18.

**B. The Shaffer et al. reference in view of the Villa-Real reference**

Regarding the rejection of claims 2, 7, and 15, the Examiner alleges that the Villa-Real reference would have been combined with the Shaffer et al. reference to form the claimed invention. Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Applicant submits that these references would not have been combined as alleged by the Examiner. Indeed, the references are directed to completely different matters and problems.

Specifically, as explained above, the Shaffer et al. reference is directed to switching and/or routing phone calls based upon a user's time-location data that is either based upon historical usage or from a user entered calendar along with caller-ID information which may customize the routing based upon the caller-ID information and also provides for call-back



reminders when a caller is unable to establish communications with a user.

In stark contrast, the Villa-Real reference is specifically directed to a cordless extension phone which may be programmed with future phone calls to be made and alert a user to make phone calls as they become due. Therefore, one of ordinary skill in the art who was concerned with switching and/or routing of phone calls as the Shaffer et al. reference is concerned with providing would not have referred to the Villa-Real reference which is concerned with the completely different and unrelated problem of alerting a user to make phone calls as they become due.

Further, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner does not even support the combination by identifying a reason for combining the references.

Even assuming arguendo that one of ordinary skill in the art would have been motivated to combine these references, the combination would not teach or suggest each and every element of the claimed invention.

The Shaffer et al. reference appears to disclose an enhanced call back feature at col. 16, line 15 - col. 17, line 10. This enhanced call back feature appear to disclose allowing a user to select a call back information window where the caller may enter data so that the caller may be prompted to call again after a predetermined period has elapsed.

The Shaffer et al. reference does not teach the feature of claim 1 such that an alert is made when a predetermined time interval has elapsed without communicating with a person based on time data stored in a phone book database.

The Examiner alleges that "time data" is a time at which the wireless communication device enters into a cell of a private network (col. 8, lines 24-35), or the time and date of an

incoming call detected by the TOL server 804 (col. 12, lines 43-49).

Rather, the Shaffer et al. reference is directed to determining based on the detected time whether the wireless communication device 202 stays in the cell, or routing the call to an appropriate destination based on the incoming call time. Accordingly, such time information is completely different from the time information.

Further, regarding claim 2, the Shaffer et al. reference does not teach or suggest time data regarding the last communication with a person. As explained above, this feature is important for determining whether a predetermined time has elapsed since the communication was last established with that person.

Rather, the Shaffer et al. reference merely stores time data regarding the time and location of a mobile telephone to determine how to switch between phone systems and also stores data regarding time and location data for predicted locations (in a calendar/scheduler) along with data identifying potential callers to determine how to forward a phone call from an identified caller.

The Examiner alleges that the Shaffer et al. reference discloses a caller calls a user and “the time of the call is stored along with the caller’s name in a database.” The Examiner cites col. 8, lines 24-35 and col. 12, lines 43-49 in an attempt to support this allegation.

However, contrary to the Examiner’s allegation, col. 8, lines 24-35 of the Shaffer et al. reference does not teach or suggest storing the caller’s name in a database along with the time of the call that established a communication as recited by claim 2.

Rather, the Shaffer et al. reference discloses that the processor 231 detects the servicing of the call and “determines the time of the call (step 452)” (emphasis added, col. 8, lines 23-25). “In addition, the processor 231 determines the location of the wireless

communication device 202 (step 454) at the time of servicing the call” (emphasis added, col. 8, lines 25-28). “Alternatively, the SSC 203 may provide control time-location information directly to the wireless private branch exchange. The processor 231 then stores the times and locations in the memory 233” (emphasis added, col. 8, lines 30-35).

The portion of the Shaffer et al. reference that the Examiner cites at col. 8, lines 24-35 is related to an embodiment of a method for deciding when to switch between wireless networks based upon a user’s past access patterns (col. 2, lines 45-65). This embodiment is directed to minimizing the number of unnecessary hand-offs between private and public networks so as to minimize charges and to enhance the quality of the call (col. 2, lines 19-23).

More particularly, this embodiment transfers calls based upon time-location associations in a manner that is similar to transfers that have been made based upon signal strength determinations (col. 7, lines 6-10). The Shaffer et al. reference describes Fig. 4 at col. 8, lines 13-46 and merely discloses detecting a call at step 450, determining the time of that call at step 452, determining the location of the telephone during the call at step 454 and then recording that data at step 456.

Alternatively, a user may also input his schedule of time-location data into a calendar that is used to provide estimates of the users transit through particular networks (Fig. 6, col. 9, lines 29 - 61).

The data that is collected using the process illustrated in Fig. 4, is used for the process that is illustrated in Fig. 5 and described at col. 8, line 46 - col. 9, line 29. That time-location data that is stored is compared with the present time and user location to determine whether to transfer a call.

Therefore, col. 8, lines 24-35 of the Shaffer et al. reference does not teach or suggest

storing the caller's name, let alone time data regarding the last communication with a person. Indeed, the Shaffer et al. reference does not teach or suggest relating time data with any person, let alone time data regarding the last communication with a person as recited by claim 2.

The Examiner also cites col. 12, lines 43-49 in an attempt to support the allegation that the Shaffer et al. reference discloses a caller that calls a user and "the time of the call is stored along with the caller's name in a database." However, contrary to the Examiner's allegation, col. 12, lines 43-49 of the Shaffer et al. reference also does not teach or suggest storing the caller's name in a database along with the time of the call as recited by claim 2.

In addition to the first embodiment described above which determines when/whether to switch/transfer calls based upon historical time-location data, the Shaffer et al. reference also discloses a second embodiment which uses a calendar that includes time-location data to determine how to forward/route calls that are received based, at least in part, upon an identification of a caller (col. 3, lines 42-55; col. 10, line 52 - col. 12, line 49).

More particularly, the Shaffer et al. reference describes "using a user's calendar to determine the routing of telephone calls" (col. 10, lines 53 - 55; and col. 11, lines 45-49). The Shaffer et al. reference explains that in addition to the user's calendar, caller-ID data may be used to supervise routing of received telephone calls (col. 11, lines 64-66). The Shaffer et al. reference discloses that a user can modify call forwarding information based upon caller identification, time and calendar information (col. 12, lines 35 - 37).

"[I]f an incoming call is received, the communication interface 904, via the controller 906, checks caller-ID information using the caller-ID unit 911. The controller 906 then accesses the server calendar interface program 916 to determine whether or not routing is

necessary based on the user's profile. If it is, then the call is routed to the desired destination" (col. 12, lines 43-49).

Therefore, the Shaffer et al. reference discloses using time-location data, whether based upon actual past usage or entered by a user in a calendar, along with caller ID data to determine how and whether to route/forward an incoming call.

The Examiner also cites col. 16, lines 47-65 of the Shaffer et al. reference for a disclosure of choosing a predetermined time since a last call was made. However, this feature which appears to be disclosed by the Shaffer et al. reference is only related to an "enhanced call-back" feature that is only triggered "if the caller is unable to reach the user" (col. 16, lines 15-26). In other words, the enhanced call-back feature is only used when there is no communication at all between the caller and the user.

The enhanced call-back feature of the Shaffer et al. reference is described using Fig. 21A and 21B. The Shaffer et al. reference clearly explains that "If a user is unavailable" (i.e. no communication is established between the caller and the user) "as determined in a step 8004, the TOL server 804, provides the caller with the option to set call back parameters, in a step 8006. . . . For example, the user may be unavailable generally, or unavailable only to a particular caller." (Col. 16, lines 47-53). Therefore, rather than storing time of the last communication as recited by claim 2, the Shaffer et al. reference discloses storing the time of the last unsuccessful attempt at communication.

Thus, in stark contrast to the present invention, the Shaffer et al. reference does not teach or suggest the features of the present invention including time data regarding the last communication with a person as recited by claim 2.

As explained above, this feature is important for determining whether a predetermined

time interval has passed since that last communication and providing an alert when that predetermined time interval has been exceeded. In this manner, the present invention ensures that a user is able to maintain periodic communications with a person.

Clearly, the Shaffer et al. reference does not teach or suggest a system which is capable of ensuring that a user is able to maintain periodic communications with a person. Rather, the Shaffer et al. reference is directed to switching/routing phone calls based upon a user's time-location data that is either based upon historical usage or from a user entered calendar along with caller-ID information which may customize the routing based upon the caller-ID information and also provides for call-back reminders when a caller is unable to establish communications with a user.

The Villa-Real reference does not remedy the deficiencies of the Shaffer et al. reference.

The Villa-Real reference discloses a telephone system in which time and date information and information related to past communications are stored to allow a user to check persons who communicated with and an alarm can be made with displaying the phone number and name of a predetermined person at a predetermined time instant.

Further, regarding claim 2, the Examiner cites col. 4, lines 12-24 in an attempt to support the Examiner's allegation that the Villa-Real reference discloses storing the last communication time of day associated with a person. However, contrary to the Examiner's allegation, the Villa-Real reference does not store the last communication time of day. Rather, the Villa-Real reference discloses storing a targeted time of day for alerting a user to place a call.

More specifically, the Villa-Real reference refers to Fig 1 and describes the functions

of the keys of the cordless phone at col. 3, line 41 - col. 5, line 51. In particular, the “Forward” and “Rearward” keys allow scrolling through a stored list of telephone numbers including the times and dates associated with those telephone numbers (col. 3, lines 54-60). When the stored times and dates match the current time and date an alarm is sounded (col. 4, lines 9-16).

The user may then use the “Asterisk” key to imprint the “\*” marking on the display window along with the block of information, such as the time and date, to provide an indication to the user that the person associated with the currently displayed block of information has been successfully contacted (col. 4, lines 16-22). In this manner, as the user scrolls through the list of times and dates associated with parties, the user can distinguish between those parties that have been contacted and those which have not yet been contacted (col. 4, lines 22-29). Thus, the user is prompted for those parties that need to be re-programmed for future prompting (col. 4, lines 29-34).

Therefore, contrary to the Examiner’s allegation, the Villa-Real reference does not teach or suggest the feature of the present invention including time data regarding the last communication with a person as recited by claim 2. As explained above, this feature is important for determining whether a predetermined time has elapsed since the communication was last established with that person.

Rather, the Villa-Real reference discloses time data for future alarms and enabling a user to append an asterisk to a record to indicate that the user has successfully contacted the person.

Indeed, the Villa-Real reference does not even address the problem of the present invention of storing time data regarding the last communication with a person and then

determining when a predetermined interval has elapsed since that last communication.

In stark contrast, the Villa-Real reference relies upon a user to enter time data regarding when an alarm should be sounded in order to prompt the user to place a call.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 2, 7, and 15.

**C. The Shaffer et al. reference in view of the Villa-Real reference**

Regarding the rejection of claims 3-5, the Examiner alleges that the Villa-Real reference would have been combined with the Shaffer et al. reference to form the claimed invention. Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Applicant submits that these references would not have been combined as alleged by the Examiner. Indeed, the references are directed to completely different matters and problems.

Specifically, as explained above, the Shaffer et al. reference is directed to switching and/or routing phone calls based upon a user's time-location data that is either based upon historical usage or from a user entered calendar along with caller-ID information which may customize the routing based upon the caller-ID information and also provides for call-back reminders when a caller is unable to establish communications with a user.

In stark contrast, the Villa-Real reference is specifically directed to a cordless extension phone which may be programmed with future phone calls to be made and alert a user to make phone calls as they become due. Therefore, one of ordinary skill in the art who



was concerned with switching and/or routing of phone calls as the Shaffer et al. reference is concerned with providing would not have referred to the Villa-Real reference which is concerned with the completely different and unrelated problem of alerting a user to make phone calls as they become due.

Therefore, one of ordinary skill in the art would not have combined the Villa-Real reference with the Shaffer et al. reference.

Further, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner does not even support the combination by identifying a reason for combining the references.

Even assuming arguendo that one of ordinary skill in the art would have been motivated to combine these references, the combination would not teach or suggest each and every element of the claimed invention.

As explained above, the Shaffer et al. reference discloses a telecommunication system in which if a caller does not receive a response from the user, the caller selects the call back information, and a predetermined time period after the caller set up, a reminder window (1270) appear on the caller's screen.

The Shaffer et al. reference does not teach the feature of claim 1 such that an alert is made when a predetermined time interval has elapsed without communicating with a person based on time data stored in a phone book database.

The Examiner alleges that "time data" is a time at which the wireless communication device enters into a cell of a private network (col. 8, lines 24-35), or the time and date of an incoming call detected by the TOL server 804 (col. 12, lines 43-49).

Rather, the Shaffer et al. reference is directed to determining based on the detected

time whether the wireless communication device 202 stays in the cell, or routing the call to an appropriate destination based on the incoming call time. Accordingly, such time information is completely different from the time information.

As explained previously, regarding claim 2, from which claims 3-5 depend, the Shaffer et al. reference does not teach or suggest the features of the present invention including time data regarding the last communication with a person. As explained above, this feature is important for determining whether a predetermined time has elapsed since the communication was last established with that person.

The Villa-Real reference does not remedy the deficiencies of the Shaffer et al. reference.

The Examiner cites col. 4, lines 12-24 in an attempt to support the Examiner's allegation that the Villa-Real reference discloses storing the last communication time of day associated with a person. However, contrary to the Examiner's allegation, the Villa-Real reference does not store the last communication time of day. Rather, the Villa-Real reference discloses storing a targeted time of day for alerting a user to place a call.

More specifically, the Villa-Real reference refers to Fig 1 and describes the functions of the keys of the cordless phone at col. 3, line 41 - col. 5, line 51. In particular, the "Forward" and "Rearward" keys allow scrolling through a stored list of telephone numbers including the times and dates associated with those telephone numbers (col. 3, lines 54-60). When the stored times and dates match the current time and date an alarm is sounded (col. 4, lines 9-16).

The user may then use the "Asterisk" key to imprint the "\*" marking on the display window along with the block of information, such as the time and date, to provide an

indication to the user that the person associated with the currently displayed block of information has been successfully contacted (col. 4, lines 16-22). In this manner, as the user scrolls through the list of times and dates associated with parties, the user can distinguish between those parties that have been contacted and those which have not yet been contacted (col. 4, lines 22-29). Thus, the user is prompted for those parties that need to be re-programmed for future prompting (col. 4, lines 29-34).

Therefore, contrary to the Examiner's allegation, the Villa-Real reference does not teach or suggest the feature of the present invention including time data regarding the last communication with a person. As explained above, this feature is important for determining whether a predetermined time has elapsed since the communication was last established with that person.

Rather, the Villa-Real reference discloses time data for future alarms and enabling a user to append an asterisk to a record to indicate that the user has successfully contacted the person.

Indeed, the Villa-Real reference does not even address the problem of the present invention of storing time data regarding the last communication with a person and then determining when a predetermined interval has elapsed since that last communication.

In stark contrast, the Villa-Real reference relies upon a user to enter time data regarding when an alarm should be sounded in order to prompt the user to place a call.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 3-5.

**D. The Shaffer et al. reference in view of the Smith reference**

Regarding the rejection of claim 8, the Examiner alleges that the Smith reference would have been combined with the Shaffer et al. reference to form the claimed invention. Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Applicant submits that these references would not have been combined as alleged by the Examiner. Indeed, the references are directed to completely different matters and problems.

Specifically, as explained above, the Shaffer et al. reference is directed to switching and/or routing phone calls based upon a user's time-location data that is either based upon historical usage or from a user entered calendar along with caller-ID information which may customize the routing based upon the caller-ID information and also provides for call-back reminders when a caller is unable to establish communications with a user.

In stark contrast, the Smith reference is specifically directed to automated telephone dialing equipment which addresses the problems of prioritizing calls to that the number of connecting calls remains fairly constant, providing enough calls to keep agents busy, but which also allows individual call records to be dialed at more appropriate times for the called party based upon experience, call history, or other similar criteria (col. 2, lines 48-54). Therefore, one of ordinary skill in the art who was concerned with switching and/or routing phone calls based upon a user's time-location data as the Shaffer et al. reference is concerned with addressing would not have been motivated to refer to the Smith reference which is directed to the completely different and unrelated problem of prioritizing calls for an automated telephone dialing equipment.

Indeed, the Shaffer et al. reference has absolutely nothing to do with automated telephone dialers, let alone prioritizing calls for an automated telephone dialer.

Further, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner does not even support the combination by identifying a reason for combining the references.

Even assuming arguendo that one of ordinary skill in the art would have been motivated to combine these references, the combination would not teach or suggest each and every element of the claimed invention.

As explained above, the Shaffer et al. reference discloses a telecommunication system in which if a caller does not receive a response from the user, the caller selects the call back information, and a predetermined time period after the caller set up, a reminder window (1270) appear on the caller's screen.

The Shaffer et al. reference does not teach the feature of claim 1 such that an alert is made when a predetermined time interval has elapsed without communicating with a person based on time data stored in a phone book database.

The Examiner alleges that "time data" is a time at which the wireless communication device enters into a cell of a private network (col. 8, lines 24-35), or the time and date of an incoming call detected by the TOL server 804 (col. 12, lines 43-49).

Rather, the Shaffer et al. reference is directed to determining based on the detected time whether the wireless communication device 202 stays in the cell, or routing the call to an appropriate destination based on the incoming call time. Accordingly, such time information is completely different from the time information.

The Smith reference discloses a system in which a lot of customers are grouped and a

call to each customer is automatically made. Therefore, it is completely different from claim 8 which recites that a before-alert time period is determined for each group. Further, the Smith reference does not disclosed determining whether the before-alert time interval has elapsed after the last-communication time of day.

Further, regarding new claims 21-24, the Shaffer et al. reference does not teach or suggest that an alert is made when a predetermined time interval has elapsed without communicating with a person based on time data stored in a phone book database in response to termination of a call to the person.

The Shaffer et al. reference appears to disclose an enhanced call back feature at col. 16, line 15 - col. 17, line 10. This enhanced call back feature appear to disclose allowing a user to select a call back information window where the caller may enter data so that the caller may be prompted to call again after a predetermined period has elapsed.

The Shaffer et al. reference does not teach or suggest telephone equipment that stores time data related to a name of a person in a phonebook database in response to termination of a call to the person. Rather, in stark contrast, the Shaffer et al. appears to require that the caller initiate a process of setting a predetermined time after which a reminder window appears to prompt the caller to place another call.

The Smith reference does not remedy this deficiency of the Shaffer et al. reference.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claim 8.

**E. The Shaffer et al. reference in view of the Smith reference and in further view of the Villa-Real reference**

Regarding the rejection of claims 9-10, and 16, the Examiner alleges that the Smith

reference would have been combined with the Shaffer et al. reference and further that the Villa-Real reference would have been combined with a combination of the Shaffer et al. reference and the Smith reference to form the claimed invention. Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Applicant submits that these references would not have been combined as alleged by the Examiner. Indeed, the references are directed to completely different matters and problems.

Specifically, as explained above, the Shaffer et al. reference is directed to switching and/or routing phone calls based upon a user's time-location data that is either based upon historical usage or from a user entered calendar along with caller-ID information which may customize the routing based upon the caller-ID information and also provides for call-back reminders when a caller is unable to establish communications with a user.

In stark contrast, the Smith reference is specifically directed to automated telephone dialing equipment which addresses the problems of prioritizing calls to that the number of connecting calls remains fairly constant, providing enough calls to keep agents busy, but which also allows individual call records to be dialed at more appropriate times for the called party based upon experience, call history, or other similar criteria (col. 2, lines 48-54). Therefore, one of ordinary skill in the art who was concerned with switching and/or routing phone calls based upon a user's time-location data as the Shaffer et al. reference is concerned with addressing would not have been motivated to refer to the Smith reference which is directed to the completely different and unrelated problem of prioritizing calls for an automated telephone dialing equipment.

Indeed, the Shaffer et al. reference has absolutely nothing to do with automated telephone dialers, let alone prioritizing calls for an automated telephone dialer.

Thus, one of ordinary skill in the art would not have combined the Smith reference with the Shaffer et al. reference.

Further, in contrast to the Shaffer et al. reference and the Smith reference, the Villa-Real reference is specifically directed to a cordless extension phone which may be programmed with future phone calls to be made and alert a user to make phone calls as they become due. Therefore, one of ordinary skill in the art who was concerned with switching and/or routing of phone calls as the Shaffer et al. reference is concerned with or prioritizing calls for an automated telephone dialing equipment as the Smith reference is concerned with would not have referred to the Villa-Real reference which is concerned with the completely different and unrelated problem of alerting a user to make phone calls as they become due.

Thus, the references would not have been combined, absent hindsight.

Further, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner does not even support the combination by identifying a reason for combining the references.

Even assuming arguendo that one of ordinary skill in the art would have been motivated to combine these references, the combination would not teach or suggest each and every element of the claimed invention.

As explained above, the Shaffer et al. reference discloses a telecommunication system in which if a caller does not receive a response from the user, the caller selects the call back information, and a predetermined time period after the caller set up, a reminder window (1270) appear on the caller's screen.



The Shaffer et al. reference does not teach the feature of claim 1 such that an alert is made when a predetermined time interval has elapsed without communicating with a person based on time data stored in a phone book database.

The Examiner alleges that “time data” is a time at which the wireless communication device enters into a cell of a private network (col. 8, lines 24-35), or the time and date of an incoming call detected by the TOL server 804 (col. 12, lines 43-49).

Rather, the Shaffer et al. reference is directed to determining based on the detected time whether the wireless communication device 202 stays in the cell, or routing the call to an appropriate destination based on the incoming call time. Accordingly, such time information is completely different from the time information.

As explained above, the Smith reference and the Villa-Real reference do not remedy the deficiencies of the Shaffer et al. reference.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 9-10, and 16.

**F. The Shaffer et al. reference in view of the Groff reference**

Regarding claim 11, The Examiner alleges that the Groff reference would have been combined with the Shaffer et al. reference to form the claimed invention. Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Applicant submits that these references would not have been combined as alleged by the Examiner. Indeed, the references are directed to completely different matters and problems.

Specifically, as explained above, the Shaffer et al. reference is directed to switching and/or routing phone calls based upon a user's time-location data that is either based upon historical usage or from a user entered calendar along with caller-ID information which may customize the routing based upon the caller-ID information and also provides for call-back reminders when a caller is unable to establish communications with a user.

In stark contrast, the Groff reference is specifically directed to a timed telephone ring silencer that allows a user to selectively disable the ringer mechanism of a telephone attached to the silencer device for a predetermined time interval. Therefore, one of ordinary skill in the art who was concerned with switching and/or routing phone calls based upon a user's time-location data as the Shaffer et al. reference is concerned with solving, would not have referred to the Groff reference which is directed to the completely different and unrelated problem of selectively disabling the ringer mechanism of a telephone attached to the silencer device for a predetermined time interval as disclosed by the Groff reference.

Thus, the references would not have been combined, absent hindsight.

Further, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner does not even support the combination by identifying a reason for combining the references.

Even assuming arguendo that one of ordinary skill in the art would have been motivated to combine these references, the combination would not teach or suggest each and every element of the claimed invention.

As explained above, the Shaffer et al. reference discloses a telecommunication system in which if a caller does not receive a response from the user, the caller selects the call back information, and a predetermined time period after the caller set up, a reminder window

(1270) appear on the caller's screen.

The Shaffer et al. reference does not teach the feature of claim 1 such that an alert is made when a predetermined time interval has elapsed without communicating with a person based on time data stored in a phone book database.

The Examiner alleges that "time data" is a time at which the wireless communication device enters into a cell of a private network (col. 8, lines 24-35), or the time and date of an incoming call detected by the TOL server 804 (col. 12, lines 43-49).

Rather, the Shaffer et al. reference is directed to determining based on the detected time whether the wireless communication device 202 stays in the cell, or routing the call to an appropriate destination based on the incoming call time. Accordingly, such time information is completely different from the time information.

The Groff reference discloses a telephone ring silencer device, which disables the ringer of a telephone connected thereto at a predetermined time zone without pulling out is modular-plug from the modular-jack or taking the handset off-hook.

Therefore, the Groff reference does not disclose determining based on the time data whether a predetermined time has elapsed without communicating with the person. Thus, the Groff reference is absolutely different from claim 11.

Further, regarding new claims 21-24, the Shaffer et al. reference does not teach or suggest that an alert is made when a predetermined time interval has elapsed without communicating with a person based on time data stored in a phone book database in response to termination of a call to the person.

The Shaffer et al. reference appears to disclose an enhanced call back feature at col. 16, line 15 - col. 17, line 10. This enhanced call back feature appear to disclose allowing a

user to select a call back information window where the caller may enter data so that the caller may be prompted to call again after a predetermined period has elapsed.

The Shaffer et al. reference does not teach or suggest telephone equipment that stores time data related to a name of a person in a phonebook database in response to termination of a call to the person. Rather, in stark contrast, the Shaffer et al. appears to require that the caller initiate a process of setting a predetermined time after which a reminder window appears to prompt the caller to place another call.

The Groff reference does not remedy this deficiency of the Shaffer et al. reference.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claim 11.

**G. The Shaffer et al. reference in view of the Groff reference and in further view of the Villa-Real reference**

Regarding claims 12-14 and 17, the Examiner alleges that the Groff reference would have been combined with the Shaffer et al. reference and further that the Villa-Real reference would have been combined with a combination of the Shaffer et al. reference and the Groff reference to form the claimed invention. Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Applicant submits that these references would not have been combined as alleged by the Examiner. Indeed, the references are directed to completely different matters and problems.

Specifically, as explained above, the Shaffer et al. reference is directed to switching

and/or routing phone calls based upon a user's time-location data that is either based upon historical usage or from a user entered calendar along with caller-ID information which may customize the routing based upon the caller-ID information and also provides for call-back reminders when a caller is unable to establish communications with a user.

In stark contrast, the Groff reference is specifically directed to a timed telephone ring silencer that allows a user to selectively disable the ringer mechanism of a telephone attached to the silencer device for a predetermined time interval. Therefore, one of ordinary skill in the art who was concerned with switching and/or routing phone calls based upon a user's time-location data as the Shaffer et al. reference is concerned with solving, would not have referred to the Groff reference which is directed to the completely different and unrelated problem of selectively disabling the ringer mechanism of a telephone attached to the silencer device for a predetermined time interval as disclosed by the Groff reference.

Thus, the Groff reference would not have been combined with the Shaffer et al. reference.

In further contrast to the Shaffer et al. reference and the Groff reference, the Villa-Real reference is specifically directed to a cordless extension phone which may be programmed with future phone calls to be made and alert a user to make phone calls as they become due. Therefore, one of ordinary skill in the art who was concerned with switching and/or routing of phone calls as the Shaffer et al. reference is concerned with or selectively disabling the ringer mechanism of a telephone attached to the silencer device for a predetermined time interval as disclosed by the Groff reference is concerned with would not have referred to the Villa-Real reference which is concerned with the completely different and unrelated problem of alerting a user to make phone calls as they become due.

Thus, the references would not have been combined, absent hindsight.

Further, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner does not even support the combination by identifying a reason for combining the references.

Even assuming *arguendo* that one of ordinary skill in the art would have been motivated to combine these references, the combination would not teach or suggest each and every element of the claimed invention.

As explained above, the Shaffer et al. reference discloses a telecommunication system in which if a caller does not receive a response from the user, the caller selects the call back information, and a predetermined time period after the caller set up, a reminder window (1270) appear on the caller's screen.

The Shaffer et al. reference does not teach the feature of claim 1 such that an alert is made when a predetermined time interval has elapsed without communicating with a person based on time data stored in a phone book database.

The Examiner alleges that "time data" is a time at which the wireless communication device enters into a cell of a private network (col. 8, lines 24-35), or the time and date of an incoming call detected by the TOL server 804 (col. 12, lines 43-49).

Rather, the Shaffer et al. reference is directed to determining based on the detected time whether the wireless communication device 202 stays in the cell, or routing the call to an appropriate destination based on the incoming call time. Accordingly, such time information is completely different from the time information.

As explained above, the Groff reference and the Villa-Real reference do not remedy the deficiencies of the Shaffer et al. reference.

As explained previously, regarding claim 12, none of the Shaffer et al. reference, the Groff reference and the Villa-Real reference teaches or suggests the features of the present invention including time data regarding the last communication with a person. As explained above, this feature is important for determining whether a predetermined time has elapsed since the communication was last established with that person.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 12-14, and 17.

**H. The Shaffer et al. reference in view of the Smith reference**

Regarding claim 19, the Examiner alleges that the Smith reference would have been combined with the Shaffer et al. reference to form the claimed invention. As explained during the personal interview, Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Applicant submits that these references would not have been combined as alleged by the Examiner. Indeed, the references are directed to completely different matters and problems.

Applicant submits that these references would not have been combined as alleged by the Examiner. Indeed, the references are directed to completely different matters and problems.

Specifically, as explained above, the Shaffer et al. reference is directed to switching and/or routing phone calls based upon a user's time-location data that is either based upon historical usage or from a user entered calendar along with caller-ID information which may

customize the routing based upon the caller-ID information and also provides for call-back reminders when a caller is unable to establish communications with a user.

In stark contrast, the Smith reference is specifically directed to automated telephone dialing equipment which addresses the problems of prioritizing calls to that the number of connecting calls remains fairly constant, providing enough calls to keep agents busy, but which also allows individual call records to be dialed at more appropriate times for the called party based upon experience, call history, or other similar criteria (col. 2, lines 48-54). Therefore, one of ordinary skill in the art who was concerned with switching and/or routing phone calls based upon a user's time-location data as the Shaffer et al. reference is concerned with addressing would not have been motivated to refer to the Smith reference which is directed to the completely different and unrelated problem of prioritizing calls for an automated telephone dialing equipment.

Indeed, the Shaffer et al. reference has absolutely nothing to do with automated telephone dialers, let alone prioritizing calls for an automated telephone dialer.

Further, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner does not even support the combination by identifying a reason for combining the references.

Even assuming arguendo that one of ordinary skill in the art would have been motivated to combine these references, the combination would not teach or suggest each and every element of the claimed invention.

As explained above, the Shaffer et al. reference discloses a telecommunication system in which if a caller does not receive a response from the user, the caller selects the call back information, and a predetermined time period after the caller set up, a reminder window



(1270) appear on the caller's screen.

The Shaffer et al. reference does not teach the feature of claim 1 such that an alert is made when a predetermined time interval has elapsed without communicating with a person based on time data stored in a phone book database.

The Examiner alleges that "time data" is a time at which the wireless communication device enters into a cell of a private network (col. 8, lines 24-35), or the time and date of an incoming call detected by the TOL server 804 (col. 12, lines 43-49).

Rather, the Shaffer et al. reference is directed to determining based on the detected time whether the wireless communication device 202 stays in the cell, or routing the call to an appropriate destination based on the incoming call time. Accordingly, such time information is completely different from the time information.

Further, regarding new claims 21-24, the Shaffer et al. reference does not teach or suggest that an alert is made when a predetermined time interval has elapsed without communicating with a person based on time data stored in a phone book database in response to termination of a call to the person.

The Shaffer et al. reference appears to disclose an enhanced call back feature at col. 16, line 15 - col. 17, line 10. This enhanced call back feature appear to disclose allowing a user to select a call back information window where the caller may enter data so that the caller may be prompted to call again after a predetermined period has elapsed.

The Shaffer et al. reference does not teach or suggest telephone equipment that stores time data related to a name of a person in a phonebook database in response to termination of a call to the person. Rather, in stark contrast, the Shaffer et al. appears to require that the caller initiate a process of setting a predetermined time after which a reminder window

appears to prompt the caller to place another call.

The Smith reference does not remedy the deficiencies of the Shaffer et al. reference.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claim 19.

**I. The Shaffer et al. reference in view of the Groff reference**

Regarding claim 20, the Examiner alleges that the Groff reference would have been combined with the Shaffer et al. reference to form the claimed invention. Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Applicant submits that these references would not have been combined as alleged by the Examiner. Indeed, the references are directed to completely different matters and problems.

Specifically, as explained above, the Shaffer et al. reference is directed to switching and/or routing phone calls based upon a user's time-location data that is either based upon historical usage or from a user entered calendar along with caller-ID information which may customize the routing based upon the caller-ID information and also provides for call-back reminders when a caller is unable to establish communications with a user.

In stark contrast, the Groff reference is specifically directed to a timed telephone ring silencer that allows a user to selectively disable the ringer mechanism of a telephone attached to the silencer device for a predetermined time interval. Therefore, one of ordinary skill in the art who was concerned with switching and/or routing phone calls based upon a user's time-location data as the Shaffer et al. reference is concerned with solving, would not have

referred to the Groff reference which is directed to the completely different and unrelated problem of selectively disabling the ringer mechanism of a telephone attached to the silencer device for a predetermined time interval as disclosed by the Groff reference.

Thus, the references would not have been combined, absent hindsight.

Further, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner does not even support the combination by identifying a reason for combining the references.

Even assuming arguendo that one of ordinary skill in the art would have been motivated to combine these references, the combination would not teach or suggest each and every element of the claimed invention.

As explained above, the Shaffer et al. reference discloses a telecommunication system in which if a caller does not receive a response from the user, the caller selects the call back information, and a predetermined time period after the caller set up, a reminder window (1270) appear on the caller's screen.

The Shaffer et al. reference does not teach the feature of claim 1 such that an alert is made when a predetermined time interval has elapsed without communicating with a person based on time data stored in a phone book database.

The Examiner alleges that "time data" is a time at which the wireless communication device enters into a cell of a private network (col. 8, lines 24-35), or the time and date of an incoming call detected by the TOL server 804 (col. 12, lines 43-49).

Rather, the Shaffer et al. reference is directed to determining based on the detected time whether the wireless communication device 202 stays in the cell, or routing the call to an appropriate destination based on the incoming call time. Accordingly, such time information

is completely different from the time information.

Further, regarding new claims 21-24, the Shaffer et al. reference does not teach or suggest that an alert is made when a predetermined time interval has elapsed without communicating with a person based on time data stored in a phone book database in response to termination of a call to the person.

The Shaffer et al. reference appears to disclose an enhanced call back feature at col. 16, line 15 - col. 17, line 10. This enhanced call back feature appear to disclose allowing a user to select a call back information window where the caller may enter data so that the caller may be prompted to call again after a predetermined period has elapsed.

The Shaffer et al. reference does not teach or suggest telephone equipment that stores time data related to a name of a person in a phonebook database in response to termination of a call to the person. Rather, in stark contrast, the Shaffer et al. appears to require that the caller initiate a process of setting a predetermined time after which a reminder window appears to prompt the caller to place another call.

The Groff reference does not remedy the deficiencies of the Shaffer et al. reference.

Indeed, the Groff reference clearly does not teach or suggest any time data at all, let alone time data regarding the last communication with a person.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claim 20.

### **III. FORMAL MATTERS AND CONCLUSION**

The Office Action objects to the Title. This Amendment amends the Title in accordance with Examiner Jamal's very helpful suggestion. Applicant respectfully requests

withdrawal of this objection.

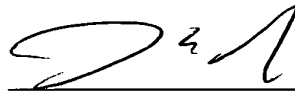
In view of the foregoing amendments and remarks, Applicant respectfully submits that claims 1-24, all the claims presently pending in the Application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the Application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 11/21/03



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